

## **REMARKS**

In view of the above amendments and the following remarks, reconsideration and further examination are respectfully requested.

### **I. Amendments to the Specification and Abstract**

The specification and abstract have been reviewed and revised to improve their English grammar. The amendments to the specification and abstract have been incorporated into a substitute specification and abstract. Attached are two versions of the substitute specification, a marked-up version showing the revisions, as well as a clean version. No new matter has been added.

### **II. Amendments to the Claims**

New claim 33 has been added to depend from independent claim 13.

Independent claims 13, 14, 31 and 32 have been amended to clarify features of the invention recited therein.

Further, claims 13, 14, 16-18, 20, 21, 24-26, 28, 29, 31 and 32 have been amended to make a number of editorial revisions thereto. These editorial revisions have been made to place the claims in better U.S. form. Further, these editorial revisions have not been made to narrow the scope of protection of the claims, or to address issues related to patentability, and therefore, these amendments should not be construed as limiting the scope of equivalents of the claimed features offered by the Doctrine of Equivalents.

### **III. 35 U.S.C. § 102 Rejections**

Initially, Applicants would like to point out that the 35 U.S.C. §102 and §103 rejections do not specifically point out where the referenced prior art discloses or suggests each and every feature of the claimed invention. When responding to these vague rejections, it is difficult to understand and/or overcome the Examiner's position because the Applicants cannot understand which portions of the references are relied upon for teaching each and every limitation of the claimed invention. As a result, it is difficult to prepare a response when the Examiner's position is not clearly understood.

Despite the vagueness of the above-mentioned rejections, Applicants have reviewed the referenced prior art and have identified differences between the claimed invention and the reference prior art. If the Examiner does not agree with the Applicants' position, the Applicants kindly request that the Examiner issue another non-final office action, that clearly discusses each and every limitation of the claimed invention and specifically identifies portions of the prior art that discloses or suggests the claimed limitations.

Claims 13-30 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kitaura et al. (U.S. 2005/020203). This rejection is respectfully traversed and is believed clearly inapplicable to amended independent claims 13 and 14 and claims 15-30 that depend therefrom for the following reasons.

Independent claims 13 and 14 recite an optical information recording medium including, in part, a reflective layer composed of a material containing at least 95 at% silver and no more than 5 at% indium. Kitaura '203 fails to disclose or suggest the above-mentioned distinguishing

features as recited in independent claims 13 and 14.

After reviewing Kitaura '203, Applicants have not found any disclosure of the above-mentioned distinguishing features, as recited in claims 13 and 14. Further, Applicants have found that Kitaura '203 merely teaches a recording medium including a changeable film that contains at least 10 atomic % germanium and no more than 50 atomic % germanium, and at least 45 atomic % tellurium and no more than 60 atomic % tellurium (see abstract). Additionally, Applicants found that paragraph [0073] of Kitaura '203 discloses a layering structure of the recording medium.

However, in view of the above, it is clear that Kitaura '203 merely teaches changeable film that contains at least 10 atomic % germanium and no more than 50 atomic % germanium, and at least 45 atomic % tellurium and no more than 60 atomic % tellurium and merely teaches a layering structure of a recording medium, but does not disclose or suggest a reflective layer composed of a material containing at least 95 at% silver and no more than 5 at% indium, as recited in independent claims 13 and 14.

Therefore, because of the above-mentioned distinctions it is believed clear that independent claims 13 and 14 and claims 15-30 and 33 that depend therefrom are not anticipated by Kitaura '203.

Further, claims 13-31 were rejected under 35 U.S.C. § 102(a) as being anticipated by Kitaura et al. (U.S. 2004/0191686). This rejection is respectfully traversed and is believed clearly inapplicable to amended independent claims 13, 14, and 31 and claims 15-30 and 33 that depend therefrom for the following reasons.

As mentioned above, independent claims 13, 14 and 31 recite a reflective layer composed

of a material containing at least 95 at% silver and no more than 5 at% indium. Kitaura ‘686 fails to disclose or suggest the above-mentioned distinguishing features as recited in independent claims 13, 14 and 31.

Rather, Kitaura ‘686 merely teaches that a reflective layer is made of  $\text{Ag}_{98}\text{Pd}_1\text{Cu}_1$  (see paragraph [0066]). In view of the above, it is clear that Kitaura ‘686 fails to disclose or suggest a reflective layer composed of a material containing at least 95 at% silver and no more than 5 at% indium, as required by claims 13, 14 and 31.

Therefore, because of the above-mentioned distinctions it is believed clear that independent claims 13, 14 and 31 and claims 15-30 and 33 that depend therefrom are not anticipated by Kitaura ‘686.

Furthermore, there is no disclosure or suggestion in Kitaura ‘203 or Kitaura ‘686 or elsewhere in the prior art of record which would have caused a person of ordinary skill in the art to modify Kitaura ‘203 or Kitaura ‘686 to obtain the invention of independent claims 13, 14 and 31. Accordingly, it is respectfully submitted that independent claims 13, 14 and 31 and claims 15-30 and 33 that depend therefrom are clearly allowable over the prior art of record.

#### **IV. 35 U.S.C. § 103(a) Rejections**

Claims 13, 15-22 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kojima et al. (U.S. 2004/0126533). This rejection is respectfully traversed and is believed clearly inapplicable to amended independent claims 13 and 31 and claims 15-22 and 33 that depend therefrom for the following reasons.

As mentioned above, independent claims 13 and 31 recite a reflective layer composed of

a material containing at least 95 at% silver and no more than 5 at% indium. Kojima fails to disclose or suggest the above-mentioned distinguishing features as recited in independent claims 13 and 31.

Rather, Kojima merely teaches a reflective layer including an Ag alloy (see paragraph [0069]). In view of the above, it is respectfully submitted that Kojima's disclosure of a reflective layer including an Ag alloy is not a disclosure or suggestion of a reflective layer composed of a material containing at least 95 at% silver and no more than 5 at% indium, as recited in claims 13 and 31.

Therefore, because of the above-mentioned distinctions it is believed clear that claims 13 and 31 and claims 15-22 and 33 that depend therefrom would not have been obvious or result from Kojima.

Furthermore, claims 13 and 15-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Terao et al. (U.S. 6,806,030). This rejection is respectfully traversed and is believed clearly inapplicable to amended independent claim 13 and claims 15-22 and 33 that depend therefrom for the following reasons.

As mentioned above, independent claim 13 recites a reflective layer composed of a material containing at least 95 at% silver and no more than 5 at% indium. Terao fails to disclose or suggest the above-mentioned distinguishing features as recited in independent claim 13.

Rather, Terao merely teaches that various layers of an optical recording medium are composed of various compounds. However, Applicants cannot identify any portion of Terao that discloses or suggests that a reflective layer composed of a material containing at least 95 at% silver and no more than 5 at% indium, as required by independent claim 13.

Therefore, because of the above-mentioned distinctions it is believed clear that claim 13 and claims 15-22 and 33 that depend therefrom would not have been obvious or result from Terao.

Moreover, claims 13-17, 20, 23-25 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kojima et al. (U.S. 2003/0179117). This rejection is respectfully traversed and is believed clearly inapplicable to amended independent claims 13 and 14 and claims 20, 23-25, 28 and 33 that depend therefrom for the following reasons.

As mentioned above, independent claims 13 and 14 recite a reflective layer composed of a material containing at least 95 at% silver and no more than 5 at% indium. Kojima ‘117 fails to disclose or suggest the above-mentioned distinguishing features as recited in independent claims 13 and 14.

Rather, Kojima ‘117 merely teaches a reflective layer that includes silver. Thus, in view of the above, it is evident that Kojima ‘117 fails to disclose or suggest a reflective layer composed of a material containing at least 95 at% silver and no more than 5 at% indium, as recited in independent claims 13 and 14.

Therefore, because of the above-mentioned distinctions it is believed clear that claims 13 and 14 and claims 20, 23-25, 28 and 33 that depend therefrom would not have been obvious or result from Kojima ‘117.

Finally, claims 18, 19, 21, 22, 26, 27, 29 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Kojima ‘117 and Terao. This rejection is respectfully traversed and is believed clearly inapplicable to claims 18, 19, 21, 22, 26, 27, 29 and 30, since, as discussed above, Kojima ‘117 and Terao fail to disclose or suggest the features of

independent claims 13 and 14.

Furthermore, there is no disclosure or suggestion in Kojima '533, Kojima '117 and/or Terao or elsewhere in the prior art of record which would have caused a person of ordinary skill in the art to modify Kojima '533, Kojima '117 and/or Terao to obtain the invention of independent claims 13, 14, 31 and 32. Accordingly, it is respectfully submitted that independent claims 13, 14, 31 and 32 and claims 15-30 and 33 that depend therefrom are clearly allowable over the prior art of record.

## **V. Double Patenting Rejections**

Claims 13-30 were provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-16 of co-pending Application No. 11/059,657.

Applicants kindly request that the Examiner hold this provisional rejection in abeyance until the claims of the present application or the claims of Application No. 11/059,657 are identified as being allowable.

Furthermore, claims 13-32 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 7,074,471. This rejection is believed clearly inapplicable to amended independent claims 13, 14, 31 and 32 for the following reasons.

As discussed above, amended independent claims 13, 14, 31 and 32 recite a reflective layer composed of a material containing at least 95 at% silver and no more than 5 at% indium.

After reviewing claims 1-23 of '471 it is apparent that claims 1-23 fails to disclose or

suggest a reflective layer composed of a material containing at least 95 at% silver and no more than 5 at% indium. As a result, it is respectfully submitted that independent claims 13, 14, 31 and 32 and claims 15-30 and 33 are in fact patentably distinct from claims 1-23 of '471.

As a result, withdrawal of this double patenting rejection is respectfully requested.

## **VI. Conclusion**

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance and an early notification thereof is earnestly requested. The Examiner is invited to contact the undersigned by telephone to resolve any remaining issues.

Respectfully submitted,

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